

REMARKS

The Specification and claims 1, 2, 5, 8, 10, 11, 15, 16, and 19 has been amended for clarification purposes only, and do not present new matter. Claims 20-22 have been added. Thus, claims 1-22 are currently pending in the case. Further examination and reconsideration of the presently claimed application is hereby respectfully requested.

Section 102 Rejections

Claims 1, 2, 5, and 6 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,951,229 to DiNicola et al. (hereinafter "DiNicola"). The standard for "anticipation" is one of fairly strict identity. A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. Of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987), MPEP 2131. DiNicola does not disclose all limitations of the currently pending claims, some distinctive limitations of which are set forth in more detail below.

DiNicola does not disclose a display system including a processor that is adapted to produce images upon a display, where the images may be compiled as a combination image of at least two of said images and presented to the buffer before being forwarded to the display. Amended independent claim 1 states in part:

A display system, comprising: a display; a display buffer... and a processor adapted to execute an application program which, when executed, produces images upon the display... wherein during a second mode the images are compiled as a combination image of at least one of said images drawn over at least another of said images and presented to the buffer before being forwarded to the display.

Support for the amendment to claim 1 may be found in dependent claim 2 and in the Specification on page 34, line 12 to page 35, line 25. The presently claimed case provides a system and method for enabling or disabling the buffering of images before those images are sent to the display. If buffering is disabled, the images may be forwarded in sequence to the display. If buffering is enabled, however, at least two of the images may be compiled as a combination image, which is presented to the display buffer before it is forwarded to the display. Independent claim 5 discloses a software component that can be configured to enable or disable combination image buffering before sending the combination image to the display.

DiNicola discloses an apparatus and method for managing multiple images in a graphic display system (DiNicola, Title). On page 2 of the Office Action, the Examiner suggests, "DiNicola teaches, in column 2, line 59 through column 3, line 16, especially column 3, lines 10-13, a system that can be configured to... combine two or more of the images and send them as a composite display image." The Examiner further suggests that DiNicola provides teaching for "presenting the image to the buffer before forwarding... in column 3, lines 62-68..." (Office Action, page 3). Though DiNicola may "combine two or more of the images to form a composite display image" (DiNicola, column 3, lines 10-13), as pointed out by the Examiner, DiNicola does not disclose that the composite display image may be presented to a display buffer before it is forwarded to the display, as taught in present claims 1 and 5.

In the passage cited by the Examiner (e.g., DiNicola, column 3, lines 62-68), DiNicola describes how output messages from processor 10 may be formatted and stored in memory buffers 24, 26, 28 and 30, as shown in Fig. 1 of DiNicola. The formatted output messages of DiNicola, however, cannot be considered equivalent to the presently claimed "combination image", since DiNicola's image mixing process is performed downstream of memory buffers 24, 26, 28 and 30. For example, DiNicola states, "Image mixer 32 reads the encoded graphics data from the memory buffers 24, 26, 28 and 30 and performs the necessary decoding and image mixing ... The merged images are passed through the color translation table 34 which generates the appropriate control signals to be passed on data line 40 to display monitor 50." (DiNicola, column 4, lines 14-30; and *see*, Fig. 1 of DiNicola). DiNicola does not disclose that the result of the image mixing process (i.e., the composite display image) may be stored in memory buffers 24, 26, 28 and 30, or in any other memory buffer, before the composite display image is forwarded to the display. In other words, DiNicola does not disclose the presently claimed process of enabling/disabling the buffering of a combination image before that image is sent to the display. As a consequence, the teachings of DiNicola do not anticipate all limitations of present claims 1 and 5.

In fact, DiNicola appears to teach away from presenting a combination image to a display buffer before forwarding the combination image to the display device. A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983); MPEP 2143.02. DiNicola teaches away from the claimed invention by explicitly stating, "[a] hardware implementation of image mixing allows the images to be combined and written directly to the video display monitor without generating an intermediate frame buffer containing the composite image. This technique improves display system efficiency in computer devices with limited processing power because movement of an object in

one plane, or changes to the images in any plane, does not require a complete regeneration of an intermediate frame buffer." (DiNicola, column 2, line 66 to column 3, line 6; emphasis added). Since DiNicola teaches away from the aforementioned claim limitations, the teachings of DiNicola cannot be used to anticipate all limitations of present claims 1 and 5.

For at least the reasons set forth above, DiNicola does not and cannot anticipate all limitations of independent claims 1 and 5. Therefore, claims 1 and 5, as well as claims dependent therefrom, are asserted to be patentably distinct over the cited art. Accordingly, removal of this rejection is respectfully requested.

Section 103 Rejections

Claims 3, 4, and 7-10 were rejected under 35 U.S.C. § 103(a) as being unpatentable over DiNicola in view of a publication written by Amy Fowler entitled "Mixing Heavy and Light Components" (hereinafter "Fowler"). In addition, claims 11-13, 18, and 19 were rejected under 35 U.S.C. § 103(a) as being unpatentable over DiNicola in view of a publication Sun Microsystems entitled "Introducing Swing" (hereinafter "Sun"). Furthermore, claims 14-17 were rejected under 35 U.S.C. § 103(a) as being unpatentable over DiNicola, Fowler, and Sun.

To establish a *prima facie* obviousness of a claimed invention, all claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974), MPEP 2143.03. Obviousness cannot be established by combining or modifying the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion or incentive to do so. *In re Bond*, 910 F. 2d 81, 834, 15 USPQ2d 1566, 1568 (Fed. Cir. 1990). The cited art does not teach or suggest all limitations of the currently pending claims, some distinctive limitations of which are set forth in more detail below.

None of the cited art provides teaching or suggestion for enabling or disabling buffering of a sequence of images as a combination image before the combination image is sent to a display. Independent claim 5 states in part:

A computer-readable memory, comprising... a software component invoked by the application program to display object code which, when executed, produces a sequence of images upon a display screen, wherein the software component can be configured during runtime of the application program to enable or disable buffering of the sequence of images as a combination image before sending the combination image to the display.

Independent claims 1, 12 and 19 recite similar limitations on enabling/disabling the buffering of images.

As noted in the § 102 arguments presented above, DiNicola appears to teach away from presenting a combination image to a display buffer (i.e., buffering a combination image) before the combination image is forwarded to a display device. Therefore, DiNicola cannot teach or suggest the presently claimed system, system components or method for enabling/disabling the buffering of a combination image before the combination image is sent to a display device, as taught in present claims 1, 5, 12, and 19. Consequently, DiNicola cannot teach or suggest all limitations of present claims 1, 5, 12, and 19.

Furthermore, none of the remaining cited art can be combined with DiNicola to overcome the deficiencies therein. For example, though Sun briefly describes the Swing component set and Fowler mentions a few problems that may be encountered when mixing Swing and AWT components, neither Sun nor Fowler disclose the manner in which these components are buffered. In other words, Sun and Fowler each fail to teach or suggest a system or method for enabling or disabling the buffering of a combination image before the combination image is sent to a display device, as taught in present claims 1, 5, 12, and 19. Consequently, Sun and Fowler cannot teach or suggest all limitations of present claims 1, 5, 12, and 19.

Since the primary reference of DiNicola teaches away from the above-mentioned claim limitation, and none of the remaining cited art provides teaching or suggestion for the claim limitation, the cited art cannot be combined in such a manner that teaches or suggests all limitations of present claims 1, 5, 12 and 19. A *prima facie* case of obviousness may be rebutted by showing that the art, in any material respect, teaches away from the claimed invention. *In re Geisler*, 116 F.3d 1465, 1471, 43 USPQ2d 1362, 1366 (Fed. Cir. 1997); MPEP 2144.05 (II).

For at least the reasons set forth above, none of the cited art, either separately or in combination provides motivation to teach or suggest all limitations of present claims 1, 5, 12, and 19. Therefore, claims 1, 5, 12, 19, and all claims dependent therefrom, are patentably distinct over the cited art. Accordingly, removal of this rejection is respectfully requested.

Patentability of the Added Claims

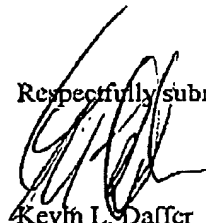
The present amendment adds claims 20-22, which are dependent from claims discussed above. As such, claims 20-22 are patentably distinct for at least the same reasons as their base claim. Accordingly, allowance of added claims 20-22 is respectfully requested.

CONCLUSION

This response constitutes a complete response to all issues raised in the Office Action mailed January 29, 2004. In view of the remarks traversing rejections, Applicants assert that pending claims 1-22 are in condition for allowance. If the Examiner has any questions, comments, or suggestions, the undersigned attorney earnestly requests a telephone conference.

No fees are required for filing this amendment; however, the Commissioner is authorized to charge any additional fees which may be required, or credit any overpayment, to Conley Rose, P.C. Deposit Account No. 03-2769/5468-07800.

Respectfully submitted,



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